UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,780	11/16/2001	John J. Daniels	14531.71.4.3	1576

47973 7590 03/16/2011

WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER	
LEE, Y YOUNG	
ART UNIT	PAPER NUMBER
2486	

MAIL DATE	DELIVERY MODE
03/16/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN J. DANIELS

Appeal 2009-008822
Application 09/993,780
Technology Center 2400

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT, and CARLA M. KRIVAK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

---

[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80, which are all of the pending claims. Claims 1, 2, 8-14, 16-36, 38, 41-43, 48-63, and 77 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed September 29, 2008), the Answer (mailed November 25, 2008), and the Reply Brief (filed January 23, 2009) for the respective details.

Appellant's Invention

Appellant's invention relates to a method for remotely controlling a video recorder. In response to selection of a television program from a programming schedule, recording instructions are provided to a recording device from a server. (*See generally* Spec. ¶¶ [0130]-[0131]).

Claim 37 is illustrative of the invention and reads as follows:

37. In a network server that communicates over a network with a recording apparatus that is configured to record television programs, a method for enabling the server to control the recording of one or more selected television programs by the recording apparatus, the method comprising the acts of:

storing a programming schedule at a server;

storing recording control information at the server, the recording control information including at least one record command that is transmittable over a network to a recording apparatus that is configured to record television programming;

the server receiving a user request, which is transmitted to the server through the Internet, for a webpage containing the

programming schedule and that identifies one or more television programs;

in response to the user request, the server providing a user Internet access to the programming schedule in the form of a navigable webpage and from which a particular television program can be selected by the user for recording;

receiving, at the server, a user selection of the particular television program to be recorded, the selection of the particular television program to be recorded being made from the navigable webpage provided to the user through the Internet; and

in response to the particular television program being selected for recording, the server transmitting recording control information to the recording apparatus over the network, the recording control information comprising recording instructions that are configured to cause the recording apparatus to record the particular television program and such that the recording apparatus will thereafter be set up to record the particular television program, and wherein the recording instructions are transmitted to the recording apparatus from the server through at least one of a television signal and the Internet.

The Examiner's Rejections

The Examiner's Answer cites the following prior art references:

Klosterman	US 5,550,576	Aug. 27, 1996
Schein	US 6,388,714 B1	May 14, 2002 (filed Apr. 11, 1997)

Claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80, all of the appealed claims, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Klosterman.

ANALYSIS

Appellant's arguments with respect to the obviousness rejection of independent claims 37 and 44, based on the combination of Schein and

Klosterman, focus on the alleged deficiency of either reference, taken alone or in combination, of teaching or suggesting the claimed invention. According to Appellant (App. Br. 12-24; Reply Br. 3-6), neither of the applied Schein or Klosterman references discloses *both* a *first request* from a recording device to a server for a programming schedule, and a *second request* from the recording device to the server for recording instructions in response to a selection from the programming schedule. In Appellant's view, the applied Schein and Klosterman references disclose, at most, only a *single* request from a recording device to a server for a programming schedule.

We agree with Appellant. Schein discloses that a request over an Internet connection is made by a user 20 for a television programming schedule which is then loaded into the hard drive of computer 12 (Fig. 1; col. 5, ll. 45-48; col. 9, ll. 7-46). The user can then select different programs from the programming schedule for automatic recording using the VCRs 34 and 36 and recording parameters such as program date and start and end times stored in memory 76 (Figs. 1-3; col. 6, ll. 29-47; col. 7, ll. 49-53; col. 8, ll. 24-27).

As argued by Appellant (App. Br. 13-14; Reply Br. 3-4), however, it is apparent that Schein uses information that is already included in the programming schedule for recording a selected program since there is no teaching or suggestion of any request made to a server for recording instructions as claimed. Similarly, with respect to the Figure 14A embodiment of Schein additionally relied upon by the Examiner, we agree with Appellant that, while a user can select "RECORD THIS PROGRAM" from a programming schedule, there is no disclosure as to how the recording

is implemented and, in particular, no disclosure of any request made to a server or any subsequent receipt from the server of recording instructions.

We also agree with Appellant (App. Br. 19-23) that, while Klosterman may disclose that a user can select a program to record from a programming schedule, it is apparent that Klosterman uses information already included in the programming schedule to implement the recording operation (Fig. 2; col. 8, l. 52–col. 9, l. 9). Accordingly, as with Schein, Klosterman has no teaching or suggestion of any request made to a server for recording instructions, nor any receipt of such recording instructions from the server as claimed.

We recognize that the Examiner, in the Response to Argument section at pages 7 and 8 of the Answer, expands upon the stated line of reasoning by suggesting that, in Schein and Klosterman, a user's initial access login to a web server corresponds to the claimed "first request." Further, the Examiner finds the user selection of a program to record from the program schedule database corresponds to the claimed "second request."

We agree with Appellant (Reply Br. 4-5), however, that, to whatever extent a selection of a program to be recorded may be considered a "request," there is no teaching or suggestion in either Schein or Klosterman that such a request is made to a server. Rather, in Schein and Klosterman, the recording "request" is made to the local recording system using information included in the programming schedule and recording parameters stored in local storage. We further agree with Appellant (Reply Br. 5) that the Examiner has never explained why it would have been obvious to initiate a recording operation by requesting recording information from a server

when the local recording systems in both Schein and Klosterman have already received recording information in the programming schedule.

For the above reasons, we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 37 and 44, nor of claims 3-7, 15, 39, 40, 45-47, 64-76, and 78-80 dependent thereon.

CONCLUSION OF LAW

Based on the analysis above, we conclude that the Examiner erred in rejecting claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80 for obviousness under 35 U.S.C. § 103(a).

DECISION

The Examiner's 35 U.S.C. § 103(a) rejection of claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80, all of the appealed claims, is reversed.

REVERSED

babc

WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111